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PEORIA IL 61629-6490

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In re Application of:

Yoshino, et al.

Patent No.: 6,945,039

Issue Date: 20 September, 2005

Application No. 10/713,667

Filed: 14 November, 2003

Attorney Docket No.: 03-220

OFFICE OF PETITIONS

ON PETITION

This is a decision on the request filed on 19 December, 2005, under 37 C.F.R. §3.81 wherein Petitioner seeks the have the Office accept the correction of the instant patent to reflect issuance in the name of the assignee, and considered under 37 C.F.R. §1.323 to correct Applicant/Petitioner's error in the issuance of the patent to the Assignee under 37 C.F.R. §1.183 (for waiver) and 37 C.F.R. §3.81—the Issue Fee transmittal was submitted with an error as to the assignee identification.

NOTE:

Petitioner is reminded and placed on Notice that the Rules of Practice mandate that Petitioner provide both the application and patent numbers, as well as filing and issue dates, in all matters regarding this patent.¹

¹ See: 37 C.F.R. §1.366 and MPEP §2515.

The petition is **DISMISSED**.

NOTES:

- (1) Any petition (and fee) for reconsideration of this decision under 37 C.F.R. §3.81 must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) will not be permitted. The reconsideration request should include a cover letter entitled “Renewed Petition under 37 C.F.R. §1.323, §1.183 and §3.81.”
- (2) Thereafter, there will be no further reconsideration of this matter.
- (3) Petitioner is cautioned always to use both the patent number and application serial number, as well as filing date and issue date when addressing matters attendant to this file.

BACKGROUND

As is evident from the caption, above, the instant application:

- was filed on 14 November, 2003; and
- issued as a patent on 29 September, 2005.

On payment of the Issue Fee, Petitioner failed to indicate properly the assignee(s) for the issuance data.

It appears that Petitioner failed to review for guidance in this matter MPEP §307 and §§1480 - 1485. (See, in particular: MPEP §1481.01.)

ANALYSIS

Congress has authorized the issuance of patents in the name(s) of the assignee(s):

35 U.S.C. §152 Issue of patent to assignee.

Patents may be granted to the assignee of the inventor of record in the Patent and Trademark Office, upon the application made and

the specification sworn to by the inventor, except as otherwise provided in this title. (Emphasis supplied.)

Pursuant to that authorization, the Office has promulgated the regulations set forth at 37 C.F.R. §3.81 that set forth the procedure applicable to the process:

§ 3.81 Issue of patent to assignee.

(a) *With payment of the issue fee:* An application may issue in the name(s) of the assignee(s) consistent with the application's assignment where a request for such issuance is submitted with payment of the issue fee, provided the assignment has been previously recorded in the Office. If the assignment has not been previously recorded, the request should be accompanied by the assignment and either a direction to record the assignment in the Office pursuant to § 3.28, or a statement under § 3.73(b).

(b) *After payment of the issue fee:* An application may issue in the name(s) of the assignee(s) consistent with the application's assignment where a request for such issuance along with the processing fee set forth in § 1.17(I) of this chapter is submitted after the date of payment of the issue fee, but prior to issuance of the patent, provided the assignment has been previously recorded in the Office. If the assignment has not been previously recorded, the request should be accompanied by the assignment and either a direction to record the assignment in the Office pursuant to § 3.28, or a statement under § 3.73(b).

(c) *Partial assignees.*

(1) If one or more assignee(s) together with one or more inventor(s) hold the entire right, title, and interest in the application, the patent may issue in the names of the assignee(s) and the inventor(s).

(2) If multiple assignees hold the entire right, title, and interest to the exclusion of all the inventors, the patent may issue in the names of the multiple assignees. (Emphasis supplied.)

Specifically, the commentary at MPEP §1481.01 provides that:

1481.01 Correction of Assignees' Names [R-3] - 1400 Correction of Patents

1481.01 Correction of Assignees' Names [R-3]

The Fee(s) Transmittal Form portion (PTOL-85B) of the Notice of Allowance provides a space (item 3) for assignment data which should be completed in order to comply with 37 C.F.R. 3.81. Unless an assignee's name and address are identified in the appropriate space for specifying the assignee, (i.e., item 3 of the Fee(s) Transmittal Form PTOL-85B), the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied.

Any request for the issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee must:

(A) state that the assignment was submitted for recordation as set forth in 37 C.F.R. §3.11 before issuance of the patent;

(B) include a request for a certificate of correction under 37 C.F.R. §1.323 along with the fee set forth in 37 C.F.R. §1.20(a); and

(C) include the processing fee set forth in 37 C.F.R. §1.17(i).

See 37 C.F.R. §3.81(b).

Petitioner appears not to have authorized all of the required fees (petition, waiver (37 C.F.R. §1.183), and certificate) and or provided general authorization in excess of a specified fee.

CONCLUSION

Accordingly, the petition is dismissed.

Further correspondence with respect to this matter should be addressed as follows:²

By mail: Commissioner for Patents³
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings
(571) 273-8300
ATTN.: Office of Petitions

By hand: Mail Stop: Petition
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁴) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

² On July 15, 2005, the Central Facsimile (FAX) Number changed to (571) 273-8300. Faxes sent to the old number no longer are routed to the new number. The number (571) 273-8300 is the only facsimile number recognized for centralized delivery. (For further information. see: <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/cfax062005.pdf>.)

³ To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.

⁴ The regulations at 37 C.F.R. §1.2 provide:
§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.